

In the Drawings

Please amend the drawings as set forth below. Attached herewith are seven replacement sheets which incorporate the amendments.

Fig. 8G Replace "86" with – 87 --.

Fig. 18I Replace three occurrences of "154" with – 155 --.

Fig. 18L Replace two occurrences of "58" with – 159 --.

Fig. 20 Replace "104B" with – 104A --.

Fig. 23 Replace "141" with – 145 – and replace "141A" with – 145A --.

Fig. 25 Replace "154" with – 155 --, replace "152A" with – 151A – and replace "152" with – 151 --.

Fig. 26 Replace "152" with – 151 --, replace "154" with – 155 --, replace "152B" with -- 151B – and replace "152A" with – 151A --.

REMARKS

Applicants have amended the Specification to delete the original claim of priority based upon Application No. 10/262,721 filed October 2, 2002.

In the above-noted Office Action, a request was made for Applicants to elect a single disclosed species. Applicants elect, with traverse, Species I (Claims 1 – 23).

In response to the above-noted Office Action, Applicants have amended Claims 1, 2, 4, 6, 7, 8, 10, 11, 13, 14 15, 16, 17, 19, 21 and 23, have cancelled Claims 12, 18 and 22, with Claims 24 – 28 (non-elected claims) being withdrawn. Thus, Claims 1 – 11, 13 – 17, 19 – 21 and 23 are presented for consideration.

Claim 1 was rejected for being anticipated by USPNo. 6,010,157 to Pierson (hereinafter Pierson) and by USPNo. 5,605,425 to Schaefer (hereinafter Schaefer). Claim 1 has been amended to further distinguish over these references. In addition, the claim was objected to as having certain informalities which have been corrected by amendment.

Claim 1 is directed to a book binding apparatus, with an exemplary embodiment being depicted in Figs 1 and 2 of the subject application. The claimed structure includes a “first cover element” such as disclosed in Figs. 1 – 3 of the application, with the “first cover element” including a “flap member” such as member 60A which forms a pocket intermediate the flap member and a “first cover section” such as bottom sheet 58. A “first section of pressure sensitive adhesive,” such as adhesive 63, is disposed “along a first edge of the first cover section”, with a “first release liner,” such as liner 64, being disposed over adhesive 63. A “second section of pressure sensitive adhesive”, such as adhesive 65, is disposed “on a surface of said flap member,” with a “second release liner disposed over the second section of the pressure sensitive adhesive”.

Claim 1 has been amended to recite “said cover section being disposed substantially exclusively in a single plane” as can be seen in Fig. 1 where cover 58 is in a single plane. Claim 1 has also been amended to recite “with said flap member being movable between a closed position where the first release liner can contact said second release liner and an open position where the flap member is positioned away from said first release liner”. Further, Claim 1 has been amended to recite that the “flap member [is] attached to the first cover section and pivotable at a first location along the first cover section, with the first location being displaced from the

first edge of the first cover section" and "at least a portion of the first section of pressure sensitive adhesive is disposed intermediate the first location and the first edge" of the first cover section.

The pocket formed by the "flap member" and the "first cover section" can be positioned for receiving the free end of another binding element, such as element 52 shown in Fig. 4. By way of example, Fig. 8J shows the free end or "extension 70A" of binding element 52 disposed within the pocket of the claimed "first cover element" formed between flap member 60A and sheet 58. As explained in the subject application at page 10, lines 2 – 13, the location of the free end 70A is a function of the thickness of the stack being bound. Among other things, the presence of the pocket allows the free end, which would terminate at varying locations, to be concealed thereby greatly enhancing the appearance of the final book.

In rejecting Claim 1, the Examiner cited element 18 of Fig. 3 of Pierson as forming the "first cover section", element 44 as forming the "flap member", element 50a as forming the "first release liner" with an underlying "first section of pressure sensitive adhesive" 48a, and element 50b as forming the "second release liner" with an underlying "second section of pressure sensitive adhesive" 48b. The Pierson structure includes six sheet-like members 20, 38, 40, 42, 44 and 46 which are folded like an accordion. Fig. 4 shows these six elements prior to final assembly partially folded, presumably for purposes of illustration. In order to attempt to meet the language regarding placing the "flap member" in a "closed position wherein the first release liner [presumably on element 38] can contact said second release liner [presumably on element 44], one would have to refold the various elements, although in what manner is not clear. There is certainly no teaching or suggestion in the cited prior art as why one of ordinary skill would be motivated to carry out such refolding much less the exact nature of the refolding. Once the structure is assembled as in Fig. 5, it is apparent that the "first release liner" is not capable of contacting the "second release liner" due to the presence of the intervening structure which includes members 40 and 42.

Thus, Claim 1 is not anticipated by Pierson and, given that the function of the Pierson structure is totally different from that of the structure of Claim 1, there is no teaching or suggestion in the prior art to somehow modify the Pierson structure to arrive at the claimed invention.

In rejecting Claim 1 in view of Schaefer, the Examiner stated that element 11 is the “first cover section”, with inner leaf 20 forming the claimed “flap member”. As understood, the outer two surfaces of leaf 20 are covered in respective layers of pressure sensitive adhesive which are, in turn, covered by respective release liners. However, it is apparent that the leaf 20 is “pivotable” at the very edge of “first cover section” 20 and not “pivotable at a first location along the first cover section, with the first location being displaced from the first edge of cover section”. In addition, none of the pressure sensitive adhesive is “disposed intermediate the first location and the first edge” since all of the adhesive is on the opposite side of the “first location”.

Thus, amended Claim 1 is not anticipated by Schaefer. Further, there is no teaching or suggestion in the cited art as to the manner in which Schaefer could be modified in some manner as to arrive at the claimed invention. Thus, for the above-noted reasons, amended Claim 1 is patentable over both Pierson and Schaefer as are Claims 2 and 3 which depend, either directly or indirectly from allowable Claim 1 and add patentably significant limitations to the claim.

Rejected Claim 4 is directed to a method of binding a stack of sheets which includes “providing a first cover element” and a “second cover element”. Fig. 4 is an exemplary embodiment of one “first cover element” which includes a “first cover section” and an “elongated spine element having a first longitudinal edge attached to an edge of the first cover section … with the spine element including a temperature activated adhesive matrix. Figs 1 and 2 are an exemplary embodiment of the “second cover element” which includes a “second cover section and a flap member attached to the second cover section and movable between and open and a closed position”. The method goes on to recite that the stack of sheets is positioned “intermediate the first and second cover sections. The “spine element” of the “first cover element” is folded “around an edge of the stack of sheets so that the adhesive matrix is facing the edge of the stack”. Then, after the folding, the spine element is secured “to the second cover section.” Also after the folding, the step of “applying heat to the spine elements so that molten heat activated adhesive contacts the edge of the stack” is carried out.

Claim 4 has been amended to recite that “second longitudinal edge” is a “free second longitudinal edge”. Further, during the “securing,” Claim 4 has been amended to recite that the “second longitudinal edge … [is] disposed intermediate

the second cover section and the flap member". Thus, the "free second longitudinal edge," the position of which is a function of the stack thickness, is concealed.

Claim 4 was rejected for being anticipated by USPNo. 4,800,110 to DuCorday (hereinafter DuCorday). As can be seen in Fig. 2 of DuCorday, a binder sheet 10 is provided having back cover section 12 and a spine section 16, with the spine section including a matrix of heat activated adhesive. Cover section 12 is positioned over one side of a stack to be bound. A cover sheet 60 is positioned on the other side of the stack and the spine section 16 is then wrapped around the edge of the stack, with the edge of the cover sheet 60 being disposed between the free end 50 of the spine section and the stack as can be seen in Fig. 4. A release liner 56 is removed so as to expose a layer of pressure sensitive adhesive 54, with the adhesive functioning to secure the end portion 50 to the cover sheet 60. Thus, unlike the method of Claim 4, the end 50 of the spine section is exposed, with the location of the end being a function of the width of the stack being bound.

For the foregoing reasons, it is submitted that DuCorday does not anticipate the method of Amended Claim 4. Further, there is no suggestion or teaching in the prior art to somehow modify the DuCorday method to arrive at the method of Claim 4. Thus, Claim 4 is believed to be patentable as are Claims 5 – 11 which depend, either directly or indirectly, from allowable Claim 4 and add patentably significant limitations to the claim.

Rejected Claim 13, which has been amended to be in independent form, is directed to a method of binding a stack of sheet to produce a hardcover book. Original Claim 13 was rejected under Section 103(a) for being unpatentable over DuCorday in view of USPNo. 5,727,816 to Ong (hereinafter Ong). According to the Examiner, Ong teaches "providing a hardcover assembly 90 including first 94 and second 92 relatively rigid hardcover sections separated by a spine section 24 ...". The Examiner goes on to combine the purported teachings of Ong with those of DuCorday. This rejection is respectfully traversed.

Applicants submit that Ong does not disclose providing any type of hardcover assembly. As shown in Figs 11 – 13 and as explained in Col. 9, line 34 et seq element 92 is not a "relatively rigid hardcover section" as recited in Claim 13 but is "card stock material" which can be readily folded as shown in Fig. 13. Similarly, element 94 is not a "relatively rigid hardcover section" as also recited in Claim 13 but rather is a "transparent plastic material" which can also be readily folded as also

shown in Fig. 13. Further, the purported “hardcover assembly” of Fig. 11 does not include a “spine segment” intermediate the two hardcover sections. Element 24 cited by the Examiner is the “binding edge” of stack being bound (Col. 10, lines 38 – 47). Arguably, the cover sections 92 and 94 are combined during the binding sequence to produce something like a spine segment, but that is not consistent with “providing a hardcover assembly” which includes the hardcover sections and spine segment. Claim 13 has been amended to recite that the “hardcover sections [are] connected by an intermediate spine segment” which clearly is not the structure shown in Fig. 11 of Ong.

It is also important to note that the cited structures of DuCorday and Ong are largely redundant so there would be no motivation to somehow combine the teachings. The method of DuCorday inherently requires that covers 22 and 60 be applied for purposes of binding using heat activated adhesive, so there would be motivation in Ong to add further covers.

For the foregoing reasons, it is submitted that amended Claim 13 is patentable over the cited prior art as is 14 which depends from Claim 13 and adds patentably significant limitations to the claim.

Claim 15 is directed to a book binding apparatus which includes a “first cover element” comprising a “folded sheet” and an “elongated spine element having a longitudinal first edge” attached to the folded sheet and with the “elongated spine element including a substrate and an adhesive matrix of heat activated adhesive disposed on the substrate. Claim 15 was also rejected for being anticipated by DuCorday, with the cited structure being present in Fig. 5 of DuCorday.

Claim 15 has been amended to recite that the “folded sheet having a fold which separates the folded sheet into first and second cover sections, with the first and second cover sections each having dimensions that generally correspond to dimensions of the sheets of the stack” to be bound. Amended Claim 5 goes on to recite the “first cover element” further includes an “elongated spine element having a longitudinal first edge attached to the folded sheet adjacent the fold in the folded sheet, with a longitudinal second edge not being attaching to the folded sheet and with the spine element including a substrate and an adhesive matrix of heat activated adhesive disposed on the substrate.”

Amended Claim 15 is believed to be patentable over the cited prior art for many reasons. By way of example, there is nothing in DuCorday that could be

considered to have a "longitudinal first edge" attached to a "folded sheet" and a "longitudinal second edge" not attached to the "folded sheet". Further, there is nothing in DuCorday or the other cited art which would teach or suggest somehow modifying DuCorday to arrive at this claimed structure.

Thus, for the above-noted reasons, amended Claim 15 is believed to be patentable as are Claims 16 and 17 which depend, either directly or indirectly, from allowable Claim 15 and add patentably significant limitations to the claim.

Rejected Claim 19 is directed to a method of binding a stack of sheets. Claim 19 has been amended, among other ways, to include various steps for encasing the bound stack in a "hardcover assembly including first and second relatively rigid hardcover sections connected by an intermediate spine segment." As previously noted in connection with Claim 13, Ong does not disclose "providing a hardcover assembly" as claimed nor does any of the cited art disclose the method of attaching the hardcover assembly to the bound stack.

For the foregoing reasons, it is submitted that amended Claim 19 is patentable as are Claims 20 – 23 which depend, either directly or indirectly, from allowable Claim 19 and add patentably significant limitations to the claim.

In conclusion, all pending claims are in condition for allowance and an early allowance is respectfully requested.

Respectfully submitted,

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